

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding.

2. **35 U.S.C. § 103**

Claims 1-5, 8-9, 14-17, 19, 23 and 50 are rejected as being unpatentable over AQC in view of U.S. patent no. 6,944,669 ("Saccocio") and further in view of Paypal. Applicant respectfully disagrees.

Applicant respectfully notes that Saccocio, as shown at reel 01169, frame 0193 was assigned to AOL, Inc. at the time of application.

Applicant also notes that the subject Application, as shown at reel 14503, frame 0876 was also assigned to AOL, Inc. at the time of application.

Further, Saccocio was not published until September 13, 2005, almost three years after the subject application's filing date of October 20, 2003.

Accordingly, under 35 U.S.C. § 103(c), because Saccocio and the subject application were commonly-owned or subject to an obligation of assignment to the same person at the time the claimed invention was made, and because Saccocio qualifies as prior art to the subject application only under 35 U.S.C. § 102(e), Saccocio is not prior art to the subject Application.

Thus, on this ground alone, the present rejection is improper because the remaining references of the combination fail to teach or suggest all elements of the independent Claims.

Furthermore, Applicant amends the present Application to claim priority from U.S patent application ser. no. 10/313,748, now U.S. patent no. 7,346,748, filed December 6, 2002. In the accompanying petition under 37 CFR §1.78(a)(3), Applicant states:

- that the priority claim has not been granted; and
- that the priority claim was made after the statutory deadline for submitting same. However, the entire delay between the date the claim was due and

the date the claim was filed was unintentional and without deceptive intent.

The amendment to the specification is necessary because it is required under 37 CFR §1.78(a)(3). The amendment was not earlier presented because a petition under 37 CFR §1.78(a)(3) had not been earlier presented.

Therefore, pending acceptance of the petition to accept an unintentionally-delayed priority claim, the subject application now enjoys a priority date of December 6, 2002.

Paypal's earliest effective date is January 16, 2003, well after the priority date of December 6, 2002. Paypal therefore does not qualify as prior art to the subject Application. Accordingly, on this ground alone, even if Saccocio qualified as prior art to the subject Application, the present rejection would be improper because AQC/Saccocio fail to teach or suggest all elements of the Claimed subject matter.

Additionally, in view of the foregoing, AQC is the only remaining reference of the combination. Because, as admitted by the Office, AQC fails to teach or suggest all elements of the Claimed subject matter, the present rejection is deemed improper. Accordingly, Applicant considers the independent Claims allowable over the combination.

In view of their dependence from allowable parent Claims, the dependent Claims are deemed allowable without any separate consideration of their merits.

Claim 12 is rejected as being unpatentable over AQC/Saccocio/Paypal and further in view of U.S. patent no. 6,807,574 ("Partovi"). In view of the foregoing, the present rejection is deemed improper.

Claim 13 is rejected as being unpatentable over AQC/Saccocio/Paypal in view of U.S. patent no. 6,807,574 ("Partovi") and further in view of Official Notice. In view of the foregoing, the present rejection is deemed improper. Even if the combination AQC/Saccocio/Paypal/Partovi qualified as prior art to the subject application the present rejection would be improper because it improperly relies on Official Notice.

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21" (emphasis added, in part). MPEP § 2144.03. Here, the Office is relying on Official Notice to assert specific knowledge of the prior art. Furthermore, it is Applicant's position that it is not capable of instant and unquestionable determination that the subject matter of Claim 13 was well known at the time of application. Accordingly, Applicant respectfully requests that the Office provide documentation in support of its assertion.

3. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on Official Notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

In view of the foregoing, the Application is deemed in allowable condition. Accordingly, Applicant respectfully requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, he is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,



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